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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

Shigeru EMOTO, et al.

SERIAL NO: 10/724,260

GROUP: 1756

FILED: December 1, 2003

EXAMINER: Janis L. DOTE

FOR: TONER, DEVELOPER INCLUDING THE TONER, CONTAINER
CONTAINING THE TONER OR THE DEVELOPER AND METHOD OF
PRODUCING THE TONER

LETTER

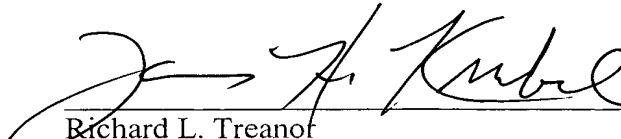
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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith is an European Office Action for the Examiner's consideration. The reference listed therein has been previously filed on February 14, 2005.

Respectfully Submitted,

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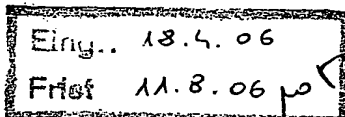
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| | | |
|--|-------------------|--------------------|
| Application No. 03 027 288.4 - 1217 | Ref. EPP03-331 | Date 11.04.2006 |
| Applicant Ricoh Company, Ltd. | | |

Communication pursuant to Article 96(2) EPC

The examination of the above-identified application has revealed that it does not meet the requirements of the European Patent Convention for the reasons enclosed herewith. If the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(1) EPC.

You are invited to file your observations and insofar as the deficiencies are such as to be rectifiable, to correct the indicated deficiencies within a period

of 4 months

from the notification of this communication, this period being computed in accordance with Rules 78(2) and 83(2) and (4) EPC.

One set of amendments to the description, claims and drawings is to be filed within the said period on separate sheets (Rule 36(1) EPC).

Failure to comply with this invitation in due time will result in the application being deemed to be withdrawn (Article 96(3) EPC).



Vanhecke, H
Primary Examiner
for the Examining Division

Enclosure(s): 3 page/s reasons (Form 2906)



The examination is being carried out on the **following application documents**:

Description, Pages

1-70 as originally filed

Claims, Numbers

1-18 as originally filed

Drawings, Sheets

½-2/2 as originally filed

1. The following document (D) is referred to in this communication; the numbering will be adhered to in the rest of the procedure:

D1 = EP-A-1205813

2. The present application does not meet the requirements of Article 52(1) EPC, because the subject-matter of claim 1 does not involve an inventive step in the sense of Article 56 EPC.

D1 discloses a toner composed of toner particles comprising: a first polyester binder resin, a second modified polyester binder resin, a colorant, a release agent and a particulate resin material at the surface of the toner particles (see in D1: claims 1, 2 and 5, page 7, lines 18-21). D1 so discloses all the compositional and structural features of present claim 1. Present claim 1 further specifies five parameter values, which are not disclosed in D1.

However, present application fails to demonstrate any effects specifically due to the combination of said claimed parameter values. The following insufficiencies in the set of examples / comparative examples prevent the establishment of such effects:

- in the examples illustrating present invention polyester and modified polyester are used as binders, whereas in the comparative examples styrene-acrylate resins are used, which



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makes a sound establishment of solely parameter based effects impossible

- the toners of the comparative examples have no particulate resin material at the surface of the toner particles

- no glass transition temperatures are provided for the resin components of the comparative examples.

- no particulate resin material is applied on the surface of the toner particles of the examples 1-9 (see page 53), which means that said examples do not represent the invention.

So examples duly representing the claimed toners as well as comparative examples representing the closest prior art toners, i.e. toners composed of similar resin material and having a similar structure (mother particles carrying particulate resin on the toner surfaces) are not provided in the present description.

The difference between the D1 toner and the toner according to present claim 1 consists in the specification of the claimed five parameter values.

As no effect due to the claimed parameter values is demonstrated, the claimed toner is considered as a mere alternative to the toner disclosed in D1.

It is also noted that the prior art D1 toners and the toners of the present examples show the same favourable values of minimum fixing temperature and offset temperature (see in D1: table 1 and table 4 in present description).

It is hence the opinion of the Examining Division that the determining of the claimed parameter values, which leads, as far as comparison is possible, to a toner which is only not inferior to the prior art toners, is not to be regarded as constituting an inventive modification of the prior art.

3. The additional features of the dependent claims 2-14 are either disclosed in D1 or they come within the scope of the customary practice followed by persons skilled in the art, especially as the advantages thus achieved can be readily contemplated in advance. Consequently, the subject-matter of claims 2-14 also appears to lack an inventive step.

4. Claims 15, 16 and 17 define respectively a carrier comprising the toner of claim 1, a container comprising the toner of claim 1 and a container comprising the claim 1 toner containing carrier of claim 15. All claims are characterised by the definition of claim 1 and are accordingly also regarded as not involving an inventive step.



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5. The application does not meet the requirements of Article 84 EPC, because claim 18 is not clear.

The expression "to react the modified polyester with the compound to prepare a reactant" is not understood, especially the term "reactant" is in the present context not clear.

The following feature found in claim 18 has been omitted from the description. They should therefore be added to the description to provide support for the claim as required by Article 84 EPC. The feature in question is: the application of a compound having an active hydrogen atom from an aqueous medium which also comprises the particulate resin material. Special care is to be taken having regard to Article 123 (2) EPC, when amending claim and/or description.

6. It is not at present apparent which part of the application could serve as a basis for a new, allowable claim. Should the applicant nevertheless regard some particular matter as patentable, an independent claim should be filed taking account of Rule 29(1) EPC. The applicant should also indicate in the letter of reply the difference of the subject-matter of the new claims vis-à-vis the state of the art and the significance thereof.